Appl. No.: 10/049,330
Group Art Unit: 1621
Applicants' Response to Paper No. 7

REMARKS

Claims 10-35 are currently pending in the present application.

Election Requirement

In Paper No. 7, the Examiner has required the election of a single invention for prosecution on the merits. The Examiner contends that the application contains claims directed to two inventions "which are not so linked as to form a single general inventive concept under PCT Rule 13.1," and thus, lack unity of invention. (*See*, Paper No. 7, p. 2).

The Examiner has identified the inventions to which the election requirement applies, as follows:

Group I, claim(s) 10-30, drawn to a process for producing esters; and

Group II, claim(s) 31-35, drawn to an apparatus.

The Examiner argues that the invention of Group I and the Invention of Group II "are related as process and apparatus for its practice." (*See, id.*). The Examiner then argues, citing §806.05(e) of the M.P.E.P., that the inventions are distinct if it can be shown that the process as claimed can be practiced by another materially different apparatus or by hand. In this instance, the Examiner argues that the claimed process "can be practiced with a materially different apparatus, such as disclosed in DE 3842843." (*See, id.*). The Examiner concludes that because of the differences described above, and because the inventions "have acquired a separate status in the art" that restriction for examination purposes is proper.

On the basis of the foregoing arguments and contentions, the Examiner has required the election of a single invention from among Groups I and II.

Traversal of the Restriction Requirement

Applicants strenuously, but respectfully, traverse the election requirement for the following reasons.

To begin with, Unity of Invention practice, not ordinary restriction practice, applies in the instant application which is a national stage U.S. application based upon an International application. Section 1893.03(d) of the M.P.E.P., 7th Edition, Revision 1, clearly

explains 37 C.F.R. §1.499, which governs Unity of Invention during the national stage, as follows: "[w]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of *claims* and (2) explain why each group lacks unity with each other group (*i.e.*, why there is no single general inventive concept) specifically describing the unique special technical feature in each group." (*See*, M.P.E.P. §1893.03(d), (*emphasis added*)).

The Examiner has identified two specific groups of claims. However, Applicants submit that the Examiner has failed to satisfy the second requirement. While the Examiner has summarily alleged that the two groups are not so linked as to form a single general inventive concept, the Examiner's further arguments are limited to an analysis under ordinary restriction practice and fail to address the necessary lack of a single general inventive concept.

Applicants respectfully submit that all of the pending claims relate to a single general inventive concept under PCT Rule 13.1, namely the production of esters of unsaturated carboxylic acids and polyhydric alcohols. Pursuant to PCT Rule 13.2, the Examiner must consider each invention as a whole with respect to "special technical features". PCT Rule 13.2 states that,

> [w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. (Patent Cooperation Treaty, Rule 13.2).

Claims 10-30 are directed to processes for producing esters and claims 31-35 are directed to apparatus for performing the process according to claim 10. Accordingly, Applicants respectfully submit that each of the claimed inventions has a common special technical feature. Therefore, the inventions relate to a single general inventive concept. Moreover, PCT Rule 13.4 specifically allows multiple dependent claims to particular embodiments which could be considered to be a separate invention.

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Finally, Applicants respectfully note that the PCT authorized officer who handled the instant application during the international stage did not have an objection based upon unity of invention.

Therefore, Applicants respectfully submit that the election requirement of a single disclosed invention for prosecution on the merits is improper, and further request reconsideration by the Examiner, withdrawal of the election requirement, and concurrent prosecution on the merits of all pending claims.

Provisional Election With Traverse

In the event the Examiner does not find Applicants' arguments with respect to the withdrawal of the election requirement persuasive, and the Examiner maintains the election requirement set forth in Paper No. 7, Applicants provisionally elect the invention identified by the Examiner as Group I, claim(s) 10-30, with traverse, for prosecution on the merits.

Respectfully submitted,

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(Date)

By: _____

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